

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* GARY W. RAMSDEN and KENNETH WAYNE LILES
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11 Appeal 2007-3141
12 Application 10/696,894
13 Technology Center 3600
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16 Decided: October 10, 2007
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19 Before TERRY J. OWENS, ANTON W. FETTING, and JOSEPH A. FISCHETTI,
20 *Administrative Patent Judges.*

21 FETTING, *Administrative Patent Judge.*
22

23 DECISION ON APPEAL
24

25 STATEMENT OF CASE

26 Gary W. Ramsden and Kenneth Wayne Liles (Appellants) seek review under
27 35 U.S.C. § 134 of a Final rejection of claims 77, 79, and 80, the only claims
28 pending in the application on appeal.

29 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

30
31 We AFFIRM.

1 The Appellants invented an automated unit for preparing an appropriate
2 mailing label, for validating receipt from a customer of a parcel, package, letter or
3 other item for shipment, and/or for collecting and holding parcels, packages,
4 letters, and other items for pick-up by one or more commercial delivery services
5 (Specification 1:17-23).

6 An understanding of the invention can be derived from a reading of exemplary
7 claim 77, which is reproduced below [bracketed matter and some paragraphing
8 added].

9 77. An automated shipping machine for use in mailing a parcel or
10 envelope comprising:

11 [1] means for receiving payment from a customer;

12 [2] a scale

13 for weighing said parcel or envelope to be mailed and
14 determining a parcel or envelope weight;

15 [3] a display for displaying

16 at least two selectable delivery options and
17 a cost for said selected delivery option and
18 a cost for a selected delivery option;

19 [4] an input system for receiving information representative of

20 a destination for said parcel or envelope to be mailed and
21 an indication of the delivery option selected by the customer,

22 said delivery option selectable from at least two delivery
23 options;

24 [5] a processor system in communication with said input system and
25 said scale for

26 receiving said information representative of
27 the destination,
28 the selected delivery option and

the weight of said parcel or envelope and
computing a cost for mailing said parcel or envelope to said
destination as a function of
said weight and
the selected delivery option;
inter means in communication with said processor
for printing a bar code label for placement on the parcel or
envelope to be mailed by the customer identifying at least said
destination representative information and
to print a shipping receipt for an amount including at least
the cost of delivering said parcel or envelope
to said destination
via the delivery option chosen by said customer.

This appeal arises from the Examiner's Final Rejection, mailed February 3, 2006. The Appellants filed an Appeal Brief in support of the appeal on February 12, 2007. An Examiner's Answer to the Appeal Brief was mailed on March 23, 2007. A Reply Brief was filed on February 12, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Tateno	US 4,836,352	Jun. 06, 1989
Hsieh	US 4,923,022	May 08, 1990
Pusic	US 5,065,000	Nov. 12, 1991

REJECTIONS

Claims 77 and 80 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hsieh and Pusic.

1 Claim 79 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hsieh,
2 Pusic, and Tateno.

3 ISSUES

4 Thus, the issues pertinent to this appeal are

- 5 • Whether the Appellants have sustained their burden of showing that the
6 Examiner erred in rejecting claims 77 and 80 under 35 U.S.C. § 103(a) as
7 unpatentable over Hsieh and Pusic.
- 8 • Whether the Appellants have sustained their burden of showing that the
9 Examiner erred in rejecting claim 79 under 35 U.S.C. § 103(a) as
10 unpatentable over Hsieh, Pusic, and Tateno.

11 The pertinent issue turns on whether Hsieh and Pusic suggest (1) displaying at
12 least two selectable delivery options with costs and (2) computing a cost for
13 mailing a parcel or envelope to a destination as a function of weight and a selected
14 delivery option.

15 FACTS PERTINENT TO THE ISSUES

16 The following enumerated Findings of Fact (FF) are believed to be supported
17 by a preponderance of the evidence.

18 *Claim Construction*

- 19 01. Claim 77 contains the limitation that a cost for mailing a parcel or
20 envelope to a destination is a function of a weight and a selected delivery
21 option.

1 02. The phrase “function” modifies “cost,” not “destination” because the
2 phrase “to a destination” is itself a modifier of cost and a destination has
3 no weight.

4 *Hsieh*

5 03. Hsieh is directed toward an automatic mailing apparatus that
6 automatically weighs, stamps and sorts mail so as to save processing
7 time in a post office (Hsieh 1:5-8).

8 04. Hsieh’s device contains a weighing device, a display screen, and letter
9 sorting keys (Hsieh 2:36-50).

10 05. After Hsieh weighs a letter or parcel, the weight of the letter will be
11 shown on the display screen. The customer may then choose the type of
12 mailing service which sort of mailing type desired by depressing one of
13 the letter-sorting keys. The postage is then calculated according to the
14 weight of the letter and the type of mailing service which the operator
15 selects. The postage will then be shown on the display screen (Hsieh
16 3:68 – 4:12).

17 *Pusic*

18 06. Pusic is directed toward electronic postage meters having a
19 microprocessor to control the printing of postage and the accounting
20 (Pusic 1:5-8).

21 07. Pusic provides an electronically controlled postage meter which
22 automatically prints the zip code, country code, special request code, and
23 identification code directly on a postcard, letter, or package in the form
24 of laser readable bar code. Pusic enables almost all mailings to be

1 weighed and labeled by an automated electronic means but if this is
2 unsuitable, a self-adhesive bar code label can be printed and manually
3 stuck on a mailing (Pusic 2:14-25).

4 08. In Pusic, an inserted mailing is automatically weighed. Its destination
5 is entered on a keyboard. A charge is automatically calculated according
6 to instructions from the machine's memory. The charge is then
7 displayed both to the employee and to the customer and upon a
8 confirmation that the charge has been paid, the mailing pressing, bar
9 code printing, and mailing dispensing procedures occur. According to
10 individual requirements, the bar code printed on a mailing or on a self-
11 adhesive label may comprise data about the mailing's destination zip
12 code, the country of destination, and any special requests with any other
13 identification code which is required for the purpose of tracking a
14 mailing with a particular special request (Pusic 2:35-49).

15 09. Pusic calculates the total postage charge based on the weight of the
16 mailing, its destination, any special request data entered on the keyboard,
17 and on any data stored in the machine's memory (Pusic 4:60-63).

18 10. One of ordinary skill in the postal fee setting art would consider a
19 delivery option to be a predictable member of the set of special request
20 data described by Pusic.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily)

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35

1 U.S.C. § 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30 (2007);
2 *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

3 In *Graham*, the Court held that that the obviousness analysis is bottomed on
4 several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
5 determined; [(2)] differences between the prior art and the claims at issue are to be
6 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383
7 U.S. at 17. See also *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The
8 combination of familiar elements according to known methods is likely to be
9 obvious when it does no more than yield predictable results.” *KSR* at 1739.

10 “When a work is available in one field of endeavor, design incentives and
11 other market forces can prompt variations of it, either in the same field or in a
12 different one. If a person of ordinary skill in the art can implement a predictable
13 variation, § 103 likely bars its patentability.” *Id.* at 1740.

14 “For the same reason, if a technique has been used to improve one device,
15 and a person of ordinary skill in the art would recognize that it would improve
16 similar devices in the same way, using the technique is obvious unless its actual
17 application is beyond his or her skill.” *Id.*

18 “Under the correct analysis, any need or problem known in the field of
19 endeavor at the time of invention and addressed by the patent can provide a reason
20 for combining the elements in the manner claimed.” *Id.* at 1742.

ANALYSIS

Claims 77 and 80 rejected under 35 U.S.C. § 103(a) as unpatentable over Hsieh and Pusic.

The Appellants argue these claims as a group.

Accordingly, we select claim 77 as representative of the group.

37 C.F.R. § 41.37(c)(1)(vii) (2006).

The Examiner found that Hsieh described all of the limitations of claim 77 except for the printing limitation [6]. The Examiner found that Pusic described limitation [6], and that one of ordinary skill would have known that printing franking codes would provide quicker delivery. The Examiner concluded that it would have been obvious to a person of ordinary skill in the art to have combined Hsieh and Pusic to achieve the claimed invention for that reason (Answer 4).

The Appellants contend that Hsieh does not compute costs based on the destination (Appeal Br. 6:Bottom ¶ - 7:Top 2 lines; 7:Second full ¶). The Appellant also contends that Pusic fails to describe a selectable delivery option (Appeal Br. 7:First full ¶). The Appellants further argue that Hsieh teaches away from claim 77 because it is limited to not computations using two variables (Appeal Br. 8:First full ¶) and there would be no reasonable expectation of success in achieving the limitations of claim 77 for similar reasons (Appeal Br. 9:Bottom ¶). The Appellants also contend there is no suggestion to combine Hsieh and Pusic (Appeal Br. 9:First full ¶). The Appellants conclude that the combination of Hsieh and Pusic do not allow for different delivery options or are limited to delivery options whose pricing is independent of destination (Appeal Br. 8:Bottom ¶ - 9:Top 2 lines).

1 The Examiner responded that the cost in claim 77 is only a function of weight
2 and delivery option (Answer 5:Bottom ¶ - 6).

3 The issue before us is whether the combined teachings of Hsieh and Pusic
4 suggested different delivery options and a cost to a destination whose pricing may
5 depend on the delivery option and whether one of ordinary skill would have
6 combined their teachings.

7 We initially take up the claim construction issue as to whether the cost in claim
8 77 is a function of destination as well as weight and delivery option. Claim 77
9 contains the limitation that a cost for mailing a parcel or envelope to a destination
10 is a function of a weight and a selected delivery option (FF 01). The phrase “to
11 said destination” modifies cost and is therefore one of the variables. However, the
12 phrase “function” modifies “cost,” not “destination” because the phrase “to a
13 destination” is itself a modifier of cost and a destination has no weight (FF 02).
14 Thus it is not necessary that the invention “calculate the mailing cost of different
15 destinations for each selected delivery option” as argued (Appeal Br. 7:Second full
16 ¶).

17 Hsieh describes a postal calculation based on weight and mailing service (FF
18 05). A mailing service is a delivery option, and therefore Hsieh describes two of
19 the three variables for postal cost.

20 Pusic describes a postal calculation based on weight and destination, along
21 with other variables, including special request data (FF 09). One of ordinary skill
22 in the postal fee setting art would consider a delivery option to be a predictable
23 member of the set of special request data described by Pusic. Thus, Pusic alone
24 would suggest computing a postal cost based on weight, destination, and delivery
25 option.

1 But even if *arguendo* Pusic did not itself suggest delivery option as a variable,
2 both Pusic and Hsieh clearly convey to one of ordinary skill computing postal costs
3 based on the variables that affect the cost. Both Pusic and Hsieh describe weight
4 as one of those variables, and each explicitly recites one of destination and delivery
5 option. Thus, a person of ordinary skill would have immediately recognized that
6 all three elements may be parameters in postal cost computations and included all
7 three in any such computation as a result. “A person of ordinary skill is also a
8 person of ordinary creativity, not an automaton.” *KSR* at 1742.

9 As to whether one of ordinary skill would have combined Pusic and Hsieh,
10 both are directed towards postal machines that automatically compute postal costs
11 (FF 03&06). Pusic describes the advantages of applying its printing technique to
12 any postal meter such as Hsieh’s (FF 07&08). Thus, Pusic itself provides the
13 suggestion to combine its teachings with Hsieh.

14 The Appellants also contend that none of the references display at least two
15 selectable delivery options (Appeal Br. 9:First full ¶).

16 Hsieh displays physical multiple selectable keys for delivery options and also
17 has a visual computer display (FF 04). One of ordinary skill in the art was
18 knowledgeable of graphic representations of such keys, along with the information
19 that selecting each key implied, at the time of the invention. One of ordinary skill
20 was also aware that relying on such graphic representations could reduce hardware
21 costs, increase reliability, and make updating their programming more efficient.
22 Thus, displaying selectable delivery options with costs and the cost for a selected
23 option would have been no more than a combination of familiar elements that
24 yielded predictable results and accordingly would have been obvious, *see KSR* at
25 1739.

1 The Appellants have not sustained their burden of showing that the Examiner
2 erred in rejecting claims 77 and 80 under 35 U.S.C. § 103(a) as unpatentable over
3 Hsieh and Pusic.

4 *Claim 79 rejected under 35 U.S.C. § 103(a) as unpatentable over Hsieh, Pusic,*
5 *and Tatenno.*

6 The Appellants argue that claim 79 is patentable for the same reasons as claim
7 77. The Appellants have not sustained their burden of showing that the Examiner
8 erred in rejecting claim 79 under 35 U.S.C. § 103(a) as unpatentable over Hsieh,
9 Pusic, and Tatenno.

10 CONCLUSIONS OF LAW

11 The Appellants have not sustained their burden of showing that the Examiner
12 erred in rejecting claims 77, 79, and 80 under 35 U.S.C. § 103(a) as unpatentable
13 over the prior art.

14 On this record, the Appellants are not entitled to a patent containing claims 77,
15 79, and 80.

16 DECISION

17 To summarize, our decision is as follows:

- 18 • The rejection of claims 77 and 80 under 35 U.S.C. § 103(a) as unpatentable
19 over Hsieh and Pusic is affirmed.
- 20 • The rejection of claim 79 under 35 U.S.C. § 103(a) as unpatentable over
21 Hsieh, Pusic, and Tatenno is affirmed.

22 No time period for taking any subsequent action in connection with this appeal
23 may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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PATENT ADMINISTRATOR
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